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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,570	06/27/2003	Akira Kikitsu	008312-0304515	4947

909 7590 06/13/2006

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EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/607,570	Applicant(s) KIKITSU ET AL.	
	Examiner Kevin M. Bernatz	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
     4a) Of the above claim(s) 1-27, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28, 29 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Response to Amendment***

1. Amendments to claims 28 and 32, filed on March 23, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

3. Claims 28, 29 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Girt (U.S. Patent No. 6,737,172 B1) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on December 23, 2005.

The Examiner notes that the amended language merely addresses the claim objections and 112 2<sup>nd</sup> Paragraph issues previously raised and do not change the scope of the claim in terms of how the Examiner previously interpreted the claimed limitations (see Paragraph 6 of the Office Action mailed December 23, 2005).

***Claim Rejections - 35 USC § 103***

4. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Girt as applied above, for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on December 23, 2005.

***Response to Arguments***

**5. The rejection of claims 28, 29 and 32 under 35 U.S.C § 102(e) and/or 103(a) - Girt**

Applicant(s) argue(s) that that “Girt does not disclose or suggest any interlayer that is similar, or identical, to interlayer M4 of claim 28” (*page 10 of response*) since the layer alleged by the Examiner “is interposed between layers 18<sub>U</sub> and 18<sub>L</sub> and not interposed between M2 or M3 and the first or second magnetic layer” (*pages 10 – 11 of response*). The Examiner respectfully disagrees.

The Examiner notes that the confusion appears to stem from a difference in scope afforded the claimed limitations. It appears that applicants are reading limitations into the claims by interpreting the claims as if the layers are “directly adjacent” each other. The Examiner notes that this is *not* how the Examiner has interpreted the claimed limitations since the claims all utilize the open transitional phase “comprising”. I.e. the elected specie of “first recording layer/M4/M2/M1/second recording layer” is still open to being read upon by structures including additional layers interspersed between the various recording and/or M# layers. As such, the disclosed structure of Gill reads on the claim limitation since the relied upon structure is:

“first recording layer/ ... /M4/M2/ ... /M1/ ... second recording layer”.

Should applicants’ wish to exclude additional layers from being present, applicants are suggest to either utilize the closed transitional phase “consisting of”, or to positively recite that the layers are “directly adjacent to each other in the order recited”.

Regarding claim 32, applicants argue that the apparatus claims of claim 32 are not “nominal” and ask the Examiner to provide an evidentiary reference (*page 11 of response*).

The Examiner notes that “nominal” is merely referring to the fact that none of the limitations directed to the apparatus are deemed unknown to an artisan of ordinary skill (and hence, the claims are *not* restrictable as being directed to a non-nominal apparatus). I.e. the Examiner notes that these limitations refer to generic structures that were present in the very first disk drive capable of recording data (applicants are invited to swear on the record otherwise if they feel they are the first to ever invent “a driving mechanism which supports and rotates the magnetic recording medium; and a mechanism which applies a recording magnetic field to the recording magnetic medium”).

While the Examiner could simply point applicants to any floppy disk drive in their office (presuming that their office still uses floppy drives and has not switched to CD-RW, etc), the Examiner will oblige applicants by pointing to Okamoto et al. (U.S. Patent No. 6,821,652 B1). The Examiner notes that Okamoto et al. clearly disclose the nominal apparatus limitations (*Figures 7 and 8, and relevant disclosure thereto*).

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

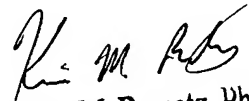
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
June 9, 2006

  
Kevin M. Bernatz, PhD  
Primary Examiner